

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

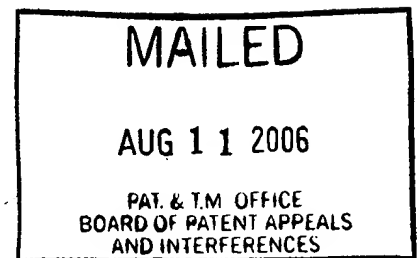
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN PETER KARIDIS, NOBORU KAMIJO,
and SUSAN SOMMERS MOFFATT

Appeal No. 2006-1008
Application 09/912,779

ON BRIEF



Before HAIRSTON, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claim 13. Pending claims 1, 3-8, 10-12 and 14 have been indicated by the examiner to contain allowable subject matter.

The disclosed invention pertains to a personal communication device comprising a dual mode display for a user's viewing in both a direct-view mode, where sufficiently-sized characters are displayed in a manner visible to the user without further magnification, and a "projection-view" mode where more content can be displayed over that of the direct-view mode.

Claim 13 is reproduced as follows:

13. A personal communication device comprising a dual mode display for a user's viewing in both a direct-view mode, wherein sufficiently-sized characters are displayed in a manner visible to the user without further magnification, and in "projection-view" mode, wherein more content can be displayed over that of the direct-view mode.

The examiner relies on the following references:

Novis et al. (Novis)	5,867,795	Feb. 02, 1999
Takahashi	6,662,244	Dec. 09, 2003
		(filed July 31, 2000)

Claim 13 stands rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Takahashi in view of Novis.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's

decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re

Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to appealed claim 13, the examiner finds that Takahashi teaches the claimed invention but does not teach magnification. The examiner cites Novis as teaching magnification in a personal communication device. The examiner finds that it would have been obvious to the artisan to include the magnification of Novis in the device of Takahashi [answer, pages 5-7].

Appellants argue that the examiner's motivation for modifying Takahashi is insufficient to support a prima facie case of obviousness. Specifically, appellants argue that the examiner's motivation appears to solve a problem in Novis, but the motivation does not allow Takahashi to display sufficiently-sized characters in a manner visible to the user without further magnification in a direct-view mode as claimed. Appellants also argue that the collective teachings of Takahashi and Novis fail to teach the dual-mode display as claimed. Specifically, appellants argue that the open and closed states of Takahashi display the same amount of content. They assert that the examiner has not cited a reference or combination of references that teaches the limitation that sufficiently-sized characters are displayed in a manner visible to the user without further magnification [brief, pages 3-9].

The examiner responds that the references can be combined because they are from the same class of wireless communication devices with display and that the motivation to combine is taken directly from the references themselves. The examiner notes that Takahashi teaches displaying sufficiently-sized characters in a manner visible to the user without further magnification. With regard to the motivation to combine, the examiner responds that Novis teaches that magnification is necessary so that there is motivation to combine. The examiner also asserts that Takahashi teaches a display that can be viewed in an open position and a closed position, and that more content can be displayed in the open position than in the closed position [answer, pages 7-14].

Appellants respond that there is nothing in Novis that suggests that magnification is necessary. They also assert that simply having references from the same class is not sufficient evidence for establishing a prima facie of obviousness. Appellants reiterate that the examiner's motivation for combining references does not address why one of ordinary skill in the art would modify Takahashi to display sufficiently-sized characters in a manner visible to the user without further magnification. They argue that the portions of Novis cited by the examiner are immaterial to overcoming the problems of Takahashi. Finally,

appellants traverse the examiner's contention that more content can be displayed in the open state of Takahashi than in the closed state [reply brief, pages 2-5].

We will sustain the examiner's rejection of claim 13. Although we also have problems with the rejection as formulated by the examiner, we agree, nevertheless, that the invention of claim 13 is rendered obvious by the applied prior art. The examiner's rejection asserts that Takahashi fails to teach magnification and looks to Novis for this teaching. The only mention of magnification in claim 13 is within the phrase "without further magnification." Thus, not only is magnification not a requirement for claim 13, but it is expressly forbidden as part of the direct-view mode. Therefore, we agree with appellants that the examiner's application of Novis for its teachings of magnification makes no sense.

Takahashi teaches a dual mode display wherein the closed state is considered as a first mode (direct-view) and the open state is considered as the second mode ("projection-view"). Appellants have not challenged the examiner's finding that Takahashi teaches these two modes. In the closed state of Takahashi, only display 5 is visible to the user because display 11 is turned off and becomes transparent [Figures 3 and 4 and

column 4, lines 58-62]. The images on display 5 are sufficient-sized characters which are visible to the user without further magnification. In the open state of Takahashi, both display 5 and display 11 can be viewed at the same time. Because the open state in Takahashi essentially adds the display area of display 11 to the display area of display 5, more content can be displayed in the open state than in the closed state [column 5, lines 1-4; column 7, line 66-column 8, line 6]. With this interpretation in mind, it is our view that Takahashi meets every feature of claim 13 and, in fact, anticipates the invention of claim 13.

Even though we affirm the examiner's rejection for different reasons than those advanced by the examiner, our position is still based upon the collective teachings of the references and does not constitute a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961); In re Boyer, 363 F.2d 455, 458 n.2, 150 USPQ 441, 442 n.2 (CCPA 1966). Note also that it is proper to affirm a rejection based upon the teachings of a lesser number of references than those relied upon by the examiner, id. Finally, anticipation is the epitome of obviousness. In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

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In summary, the decision of the examiner rejecting claim 13 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

KENNETH W. HAIRSTON
Administrative Patent Judge

Gerry Smith
JERRY SMITH
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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APPEALS AND
INTERFERENCES

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